

REMARKS

This Reply is in response to the Office Action mailed on January 21, 2004 in which Claims 29-61 were rejected. With this Reply, Claims 62-65 are added. Claims 29-65 are presented for reconsideration and allowance.

I. Examiner Interview Summary.

On April 5, 2004, a telephonic interview was held between Examiner Liang and Applicant's attorney, Todd A. Rathe. U.S. Patent Nos. 3,990,670 and 6,290,349 were discussed. In addition, the rejections of Claims 29, 37, 42, 44, 49 and 52 were also discussed. Although no specific agreement was reached, Applicant wishes to thank Examiner Liang for the opportunity to discuss the rejections and for Examiner Liang's suggestions for amending the claims to overcome the rejections.

II. Rejection of Claims 29-38, 41-44, 48-55 and 58-61 Under 35 U.S.C. § 103 Based Upon Silverbrook and Frechtman.

Page 2 of the Office Action rejected Claims 29-38, 41-44, 48-55 and 58-61 under 35 U.S.C. § 103 as being unpatentable over Silverbrook et al., U.S. Patent No. 6,290,349 in view of Frechtman, U.S. Patent No. 3,990,670. With this Reply, independent Claims 29, 58 and 59 are amended. Claims 29-38, 41-44, 48-55 and 58-61, as amended, overcome the rejection based upon Silverbrook in view of Frechtman.

A. Claim 29.

Independent Claim 29, as amended, recites a media processing device which includes a media processing engine having a media input along a first external face of the device and an output along a second external face of the device. The media input is further configured such that a portion of a medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine.

Neither Frechtman nor Silverbrook, alone or in combination, disclose or suggest a media processing device having a media input along a first external face and a media output

along a second external face of the device and wherein the media input is configured such that a portion of a medium extends outwardly beyond the input as the medium is mechanically fed towards the engine. In contrast, Frechtman merely relates to a convertible frame support for a picture. Silverbrook merely discloses a printer which has an internal compartment storing paper to be printed upon. Silverbrook does not have a media input along an external face. Moreover, Silverbrook does not have a media input which is configured such that a portion of medium extends outwardly beyond the input as the medium is being mechanically fed towards its engine.

During the Examiner interview held on April 4, 2004, a question was raised with respect to Figure 3 of Silverbrook which discloses a media tray 607 in an open position for loading of paper. However, even assuming arguendo, that Figure 3 illustrates an external face and a media input, Silverbrook does not disclose a media input configured such that a portion of a medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine. In fact, Silverbrook basically states that “When the front cover 608 is sensed closed, a release mechanism allows the sprung platen to push the paper 604 against a motorized media pick-up roller 626 shown in Figure 7.” (col. 4, lines 55-58). Thus, Silverbrook makes clear that the front cover 608 of the media tray must be closed prior to the paper being mechanically fed towards the engine. In contrast, the media processing device of Claim 29 has an input configured such that a portion of the medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine. Accordingly, independent Claim 29, as amended, overcomes the rejection based upon Silverbrook in view of Frechtman. Claims 30-38, 41-44 and 48-55 overcome the rejection for the same reasons.

B. Claim 37.

Claim 37 depends from Claim 29 and recites that the structure for which the media processing device may be used with has a top along the uppermost extremity of its vertical surface. Claim 37 further recites that the support of the media processing device is configured to extend opposite the top.

Neither Silverbrook nor Frechtman disclose the device of Claim 37. In particular, neither Silverbrook nor Frechtman disclose a support configured to couple the engine to the structure such that the media output is below the uppermost extremity of the vertical surface and wherein the support is configured to extend opposite the top of the structure. In contrast, Silverbrook merely discloses a printer which is described as being “vertically-mounted”. Pages 4 and 5 of the Office Action acknowledged that Silverbrook does not disclose a support coupled to the engine and configured to couple the engine to the structure such that the media output is below the uppermost extremity of a vertical surface. As a result, the Office Action relies upon Frechtman. However, Frechtman merely discloses a convertible picture frame support which enables a picture frame to be stood up on a horizontal surface in a first position and which also permits a picture frame to be hung from a nail. The Office Action asserts that it would be obvious to modify Silverbrook based upon the convertible picture frame support disclosed by Silverbrook. However, neither Silverbrook nor Frechtman provide any motivation or suggestion for such a combination. Silverbrook fails to contain any suggestion or motivation for supporting the printer of Silverbrook upon a horizontal surface or in a fashion similar to a stand-up picture frame. Frechtman fails to provide any motivation or suggestion that its structure may be used in a printing device. The alleged modification of Silverbrook based upon Frechtman appears to be based upon impermissible hindsight reasoning.

Even assuming arguendo, that it were obvious to modify the printer of Silverbrook to include the convertible picture frame support of Frechtman, the resulting combination would still fail to provide a printer having a support configured to extend opposite a top of a vertical surface while supporting the media output below an uppermost extremity of the same vertical surface. At most, adding the convertible picture frame support of Frechtman to the printer of Silverbrook would result in the printer of Silverbrook being hung by a nail projecting from a wall. The convertible frame support of Frechtman, even if somehow secured to the printer of Silverbrook, would not be configured so as to extend opposite a top of the vertical surface along which the printer would be suspended. Accordingly, Claim 37, as amended, overcomes the rejection for this additional reason. Claim 38 depends from Claim 37 and overcomes the rejection for the same reasons.

C. Claim 41.

Claim 41 depends from Claim 29. Claim 41, as amended, additionally recites that the support is movable between a first position in which the support is configured to couple the engine to the structure along the first vertical surface by wrapping around a top of the structure and a second position in which the support rests upon a horizontal surface while inclinating at least of the engine above the horizontal surface.

Neither Silverbrook nor Frechtman, alone or in combination, disclose or suggest an image-forming device having such a support. Even assuming, arguendo, that it would be obvious to modify Silverbrook based upon Frechtman, such a hypothetical combination would still fail to disclose the support recited in Claim 41. In particular, the convertible frame support disclosed by Frechtman is not configured to wrap around a top of a structure.

In rejecting other claims, the Office Action relies upon a toilet paper holder as disclosed by Marshall, U.S. Patent No. 4,074,872. However, as noted above, it would not be obvious to further modify Silverbrook based upon Marshall. Moreover, neither bracket 20 nor hook 25 of Marshall is movable to a position in which the bracket rests upon a horizontal surface. Accordingly, Claim 41, as amended, is believed to overcome the rejections based upon Silverbrook and Frechtman for this additional reason and is believed to be patentably distinct over the prior art of record, including Marshall.

D. Claim 42.

Claim 42 depends from Claim 29 and further recites that the support is movable between a first position in which a majority of the support extends beyond the media input and a second position in which the majority of support extends between the media input and the media output. Examples of the first and second positions are shown in Figures 2 and 3 of the present application.

Neither Silverbrook nor Frechtman disclose a support that is movable between a first position in which a majority of the support extends beyond the media input and a second position in which the majority of the support extends between the media input and the media

output. Even assuming arguendo, that it would be obvious to modify Silverbrook based upon Frechtman, the convertible picture frame support of Frechtman cannot be pivoted to a position such that a majority of the frame support extends beyond the media input. As set forth in Frechtman, the counterclockwise pivoting action of stand 16 “continues until upper U-shaped portion 16B contacts rear hanger segment 14C which is in contact with the upper edge of frame 10. It is this stopping or braking action which is illustrated in Figure 4.” (col. 6, lines 46-50). Thus, not only does Frechtman not disclose a support which pivots to a position in which a majority of the support extends beyond the media input, Frechtman actually teaches away from such movement. Accordingly, Claim 42 overcomes the rejection based upon Silverbrook and Frechtman for this additional reason.

E. Claim 49.

Claim 49 depends from Claim 48 which depends Claim 29 and recites that the device further includes a media receiver proximate the media output. Claim 49 additionally recites that the media receiver pivots between a first position in which the receiver hangs below the media output and a second position in which the media receiver is adapted to rest upon a horizontal surface. Neither Silverbrook nor Frechtman disclose or suggest a media receiver which pivots. Accordingly, Claim 49 overcomes the rejection based upon Silverbrook and Frechtman for this additional reason.

F. Claim 51.

Claim 51 depends from Claim 50 which depends from Claim 48 which depends from Claim 29. Claim 48 recites that the device further includes a media receiver while Claim 50 recites that the receiver receives media from the media output while the media is in a substantially vertical orientation. Claim 51 further recites that the receiver is configured to support the media in a tilted orientation directed away from the vertical surface. Neither Silverbrook nor Frechtman disclose a receiver which is configured to support media in a tilted orientation directed away from the vertical surface. In contrast, Silverbrook discloses a collection tray 619 in Figure 2 which supports media 618 in a non-tilted orientation. In fact, the floor of collection tray 619 of Silverbrook is specifically sloped such that if media 618

would tilt, it would tilt in an opposite direction towards the supporting vertical surface rather than away from the vertical surface. Accordingly, Claim 51 overcomes the rejection based upon Silverbrook and Frechtman for this additional reason.

G. Claim 52.

Claim 52 depends from Claim 51 and further recites that the receiver is configured to support the media such that at least a portion of the media extends beyond a front of the print engine opposite the vertical surface. An example of the receiver of the present application doing such is shown in Figure 2. This enables media 18 to be easily withdrawn.

Neither Silverbrook nor Frechtman disclose a receiver which is configured to support media such that a portion of the media extends beyond the front of the print engine opposite the vertical surface. In contrast, Silverbrook merely discloses a media collection tray 619 which is specifically configured to prevent media from extending beyond a front of the print engine opposite the vertical surface. In particular, the floor of tray 619 is sloped towards the vertical surface to prevent the media 618 from tilting away from the vertical surface. Accordingly, Claim 52 overcomes the rejection based upon Silverbrook and Frechtman for this additional reason.

H. Claim 58.

Independent Claim 58, as amended, recites a media processing device which includes a media processing engine having a media input along a first external face of the device and an output along a second external face of the device. The media input is further configured such that a portion of a medium extends outwardly beyond the input as the medium is being mechanically fed towards the engine.

Neither Frechtman nor Silverbrook, alone or in combination, disclose or suggest a media processing device having a media input along a first external face and a media output along a second external face of the device and wherein the media input is configured such that a portion of a medium extends outwardly beyond the input as the medium is mechanically fed towards the engine. In contrast, Frechtman merely relates to a convertible frame support for a

picture. Silverbrook merely discloses a printer which has an internal compartment storing paper to be printed upon. Silverbrook does not have a media input along an external face. Moreover, Silverbrook does not have a media input which is configured such that a portion of medium extends outwardly beyond the input as the medium is being mechanically fed towards its engine. Accordingly, independent Claim 58, as amended, overcomes the rejection based upon Silverbrook in view of Frechtman.

I. Claim 59.

Independent Claim 59 recites a method for processing media. The method includes supporting a device having a media processing engine along a vertical surface, feeding media through a media input along an external face of the device to the engine while the media is substantially vertical, printing upon the media and discharging the printed media out an external media output from the engine while the media is in the substantially vertical orientation.

Neither Silverbrook nor Frechtman, alone or in combination, disclose or suggest a method for processing media wherein media is mechanically fed through an input along an external face of the device. In contrast, Frechtman merely discloses a convertible picture frame support. Silverbrook merely discloses a vertically mounted printer having a hinged media tray 607 with a front cover 608. Silverbrook does not include a media input along an external face of the overall device. Moreover, even when tray 607 is opened as shown in Figure 3 of Silverbrook, Silverbrook does not disclose mechanically feeding media through the media input along an external face of the device. As noted above with respect to independent Claim 1, Silverbrook specifically states that front cover 608 must be closed for a motorized media pickup roller 626 to contact paper 604. (See col. 4, lines 55-58). Accordingly, Claim 59, as amended, overcomes the rejection based upon Silverbrook and Frechtman. Claims 60 and 61 depend from Claim 59 and overcome the rejection for the same reasons.

V. Rejection of Claims 39 and 40 Based Upon Silverbrook, Frechtman and Marshall.

The Office Action rejected Claims 39 and 40 under 35 U.S.C. § 103 as being unpatentable over Silverbrook and Frechtman and further in view of Marshall Jr., U.S. Patent No. 4,074,872. Claim 39 depends from Claim 38 which recites that the support extends opposite the first vertical surface. Claim 39 depends from Claim 38 and further recites that the structure has a second vertical surface opposite the first vertical surface and that the top extends between the first vertical surface and the second vertical surface. Claim 39 further recites that the support is configured to wrap around the structure to extend opposite the second vertical surface. Claim 40 depends from Claim 37 and recites that the structure has a second vertical surface opposite the first vertical surface and that the top extends between the first vertical surface and the second vertical surface. Claim 40 further recites that the support is configured to extend opposite the second vertical surface.

Neither Silverbrook, Frechtman nor Marshall render the device of Claims 39 and 40 obvious under 35 U.S.C. § 103. The Office Action acknowledges that neither Silverbrook nor Frechtman disclose a support that wraps around the structure to extend opposite the second vertical surface while supporting the media output below an uppermost extremity of the vertical surface. As a result, the Office Action additionally recites and relies upon Marshall which discloses an emergency bathroom tissue holder. The Office Action asserts that it would be obvious to one of ordinary skill in the art to modify Silverbrook based upon the toilet paper holder of Marshall to avoid “putting unsightly nail marks into a vertical structure in order to vertically mound (sic) the media processing device.”

However, in contrast to the assertion made in the Office Action, it would not be obvious to one of ordinary skill in the art of printing devices to even look to bathroom toilet paper holders or to modify the printer of Silverbrook based upon the bathroom tissue holder. To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art. See MPEP 2141.01(a). In particular, “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was

concerned.” In re Oetiker, 977 Fed. 2d 1443, 1446 (Fed. Cir. 1992). In the present case, Claims 39 and 40 relate to a media processing device. Silverbrook relates to a printer. However, Marshall relates to a completely different field of endeavor, a toilet paper holder. The field of an image-processing device or printer is clearly distinct from that of a toilet paper holder. Moreover, the problems being solved are immensely different. The present invention relates to a support for suspending an image-forming device along a vertical surface. In contrast, Marshall relates to a bracket for suspending a platform upon which a toilet paper roll is rotatably supported. A person of ordinary skill in the art in image-processing devices or printers would not reasonably be expected or motivated to look to toilet paper holders. Because Marshall is not analogous prior art, Applicant respectfully submits that those rejections under 35 U.S.C. § 103 based at least in part upon Marshall are improper and should be withdrawn.

IV. Rejection of Claims 45 and 46 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Khormaeae.

Page 9 of the Office Action rejected Claims 45 and 46 under 35 U.S.C. § 103 as being unpatentable over Silverbrook in view of Frechtman and further in view of Khormaeae, U.S. Patent No. 5,397,192. Claims 45 and 46 depend from Claim 29 and overcome the rejection based upon Silverbrook, Frechtman and Khormaeae for the same reasons discussed above with respect to Claim 29.

V. Rejection of Claim 47 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Kikuchi.

Page 10 of the Office Action rejected Claim 47 under 35 U.S.C. § 103 as unpatentable over Silverbrook in view of Frechtman and further in view of Kikuchi, U.S. Patent No. 5,929,894. Claim 47 depends from Claim 29 and overcomes the rejection based upon Silverbrook, Frechtman and Kikuchi for the same reasons discussed above with respect to Claim 29.

VI. Rejection of Claims 56 and 57 Under 35 U.S.C. § 103 Based Upon Frechtman and Silverbrook.

Page 11 of the Office Action rejected Claims 56 and 57 under 35 U.S.C. § 103 as being unpatentable over Frechtman in view of Silverbrook. Claim 56, as amended, recites a support for use with a media processing engine, a parapet wall and a horizontal surface. The support includes a U-shaped portion adapted to be movably coupled to the media processing engine. The support moves between a first position in which the U-shaped portion is configured to receive a top of the parapet wall and a second position in which the portion rests upon the horizontal surface.

Neither Frechtman nor Silverbrook, alone or in combination, disclose a support for having a U-shaped portion which moves between a first position in which the U-shaped portion is configured to receive a top of a parapet wall and a second position in which the portion rests upon a horizontal surface. In contrast, Silverbrook merely discloses a vertically mounted printer. Frechtman merely discloses a convertible picture frame support. Support 12 of Frechtman does not include a U-shaped portion configured to receive a top of a parapet wall. Although Figure 2 of Frechtman illustrates support 12 as having a lower upturned portion, this upturned portion is not configured to receive a top of the parapet wall. Moreover, this upturned portion does not rest upon a horizontal surface as shown in Figure 2 of Frechtman. Accordingly, Claim 56, as amended, overcomes the rejection based upon Frechtman in view of Silverbrook. Claim 57 depends from Claim 56 and overcomes the rejection for the same reasons.

VII. Added Claims.

With this Reply, Claims 62-65 are added. Added Claims 62-65 are presented for consideration and allowance.

A. Claims 62 and 63.

Claims 62 and 63 depend from Claim 29. Claims 62 and 63 are patentably distinct over the prior art of record for the same reasons discussed above with respect to Claim 29.

Moreover, Claims 62 and 63 recite additional features which further patentably distinguish such claims over the prior art of record.

B. Claims 64.

Added independent Claim 64 recites a device which includes a media processing engine and an enclosure about the media processing engine. The device of added Claim 64 further includes a support and a receiver. The support pivots between a first position in which the support is configured to wrap about a top edge of a wall and a second position in which the support is configured to rest upon a horizontal surface so as to elevate at least a portion of the enclosure above the horizontal surface. The receiver pivots between a third position in which the receiver extends along the wall while the support wraps about a top edge of the wall and a fourth position in which the receiver extends along the horizontal surface while the support rests upon the horizontal surface and inclines the enclosure above the horizontal surface. These various positions are shown in Figures 2 and 3. The media processing engine and the enclosure about the media processing engine are shown in Figure 4. Accordingly, no new matter is believed to be added.

The prior art of record fails to disclose a media processing device having a recited support and receiver which both pivot so as to cooperate with one another to enable a single media processing device to be positioned either along a vertical surface of a wall or to alternatively rest upon a horizontal surface such as a desktop. Accordingly, added Claim 64 is presented for consideration and allowance. Added Claim 65 depends from Claim 64 and is believed to be patentably distinct over the prior art of record for the same reasons.

VIII. Conclusion.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025 . Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025 . If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025 .

Respectfully submitted,

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